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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,829	01/12/2001	Stuart Berkowitz	668437600002	1904

7590 07/24/2006

John .v. Bienacki  
Jones, Day, Reavis & Pogue North Point  
901 Lakeside Avenue  
Cleveland, OH 44114

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/759,829

Applicant(s)

BERKOWITZ ET AL.

Examiner

Yehdega Retta

Art Unit

3622

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 11-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/28/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is in response to amendment filed May 11, 2006. Applicant amended claims 1 and 14 and canceled claims 9, 10, 29 and 30.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 11-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,324,519) further in view of Petty et al. (US 6,337,858).

Regarding claims 1-4, Eldering teaches receiving bids data from advertisement providers over a network, wherein an audio advertisement (see col. 1 lines 37-56, col. 4 lines 7-11) is played over the network if a bid data is determined satisfactory, receiving asking data over the network to determine whether the bid data is satisfactory (see col. 10 lines 29-64); determining whether the bid data is satisfactory and storing and playing an audio advertisement after the bid data is determined satisfactory (see abstract, col. 1 lines 37-56, col. 3 lines 1-55, col. 11 lines 37-47). Eldering teaches this can also occur when the content/opportunity provider is also the cable operator or telephone company. And in such instances, the cable operator or telephone company can be providing content to consumer over the cable operator/telephone company access network. As an example, if the cable operator has control over the content being transmitted to the consumer 100, and has programmed times for the insertion of advertisements, the cable operator is considered to be a content/opportunity provider 160 since the cable operator can

Art Unit: 3622

provide advertisers the opportunity to access consumer by inserting an advertisement at the commercial break. However failed to teach that the user uses telephony server to access the service. Petty teaches user using a telephony server to access a service that is located on the network providing service and storing the audio advertisement to the user; wherein the service is a voice markup language application located on the Internet (see col. 5 lines 1-14, col. 7 line 65 to col. 8 line 18 and col. 13 lines 28-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Eldering's bidding system to select an advertisement in Petty's VoIP based on the highest bidder as taught in Eldering.

Regarding claims 5-8, 11-13, Eldering teaches storing a plurality of audio advertisements in a database; receiving a request to retrieve at least one of advertisements based upon predetermined selection rules; based on user profile; based on ad usage rules; based on profit rules (see fig. 6&7, col. 9 line 7 to col. 12 line 32; wherein the advertisement is played over the network to users of the telephony services; wherein the service is a voice markup language application located on the Internet (see col. 3 lines 1-55, col. 9 line 32 to col. 10 line 16); receiving ad usage data (see col. 4 lines 37-65, col. 8 lines 15-39).

Regarding claims 14-28, Eldering teaches a database that stores audio advertising data; an advertising retrieval server retrieves audio advertising data based upon predetermined selection rules (see col. 4 lines 36-54 and playing over a network to users of telephony services based upon the retrieved audio advertising data (see col. 3 lines 1-64); wherein the network is an Internet network (see fig. 1); an identifier that identifies an audio file containing an advertisement to be played (see col. 9 lines 1-67); a request to provide the advertisement to users of telephony services; retrieving the advertisement based on user profile (see fig. 7, col. 9-lines

Art Unit: 3622

32-49); usage rules to determine which ad to retrieve; receiving bid data from advertisement provider; receiving asking data to determine if the bid is satisfactory; (see fig. 7 and abstract, col. 1 lines 37-56, col. 3 lines 1-55, col. 4 lines 37-65, col. 8 lines 15-39, col. 10 lines 29-64). Eldering teaches this can also occur when the content/opportunity provider is also the cable operator or telephone company. And in such instances, the cable operator or telephone company can be providing content to consumer over the cable operator/telephone company access network. As an example, if the cable operator has control over the content being transmitted to the consumer 100, and has programmed times for the insertion of advertisements, the cable operator is considered to be a content/opportunity provider 160 since the cable operator can provide advertisers the opportunity to access consumer by inserting an advertisement at the commercial break. However failed to teach that the user uses telephony server to access the service. Petty teaches user using a telephony server to access a service that is located on the network providing service and storing the audio advertisement to the user; wherein the service is a voice markup language application located on the Internet (see col. 5 lines 1-14, col. 7 line 65 to col. 8 line 18 and col. 13 lines 28-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Eldering's bidding system to select an advertisement in Petty's VoIP based on the highest bidder as taught in Eldering.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8 and 11-28 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER